

REMARKS

Claims 4, 8-17 and 27 are pending in the present application. Claim 27 has been amended, and Claims 25 and 26 have been cancelled, herewith. Reconsideration of the claims is respectfully requested.

I. Claim Objection

The Examiner objected to Claims 25, 26 and 27, stating that it appears that the word "superposition" should be replaced by "superimposition".

Claims 25 and 26 are being cancelled herewith, without prejudice or disclaimer. As to Claim 27, while a review of The American Heritage Dictionary, Fourth Edition published by Houghton Mifflin Company indicates that these two terms are synonymous with one another, Applicants are amending Claim 27 in accordance with the Examiner's objection in order that this case can expeditiously pass to issuance. Such claim is not being amended for purposes of patentability.

Therefore, this claim objection has been overcome.

II. 35 U.S.C. § 102, Anticipation

The Examiner rejected Claim 25 under 35 U.S.C. § 102 as being anticipated by Shimano et al. (US 20040196771A1). This rejection is respectfully traversed, as such claim is being cancelled herewith without prejudice or disclaimer.

III. 35 U.S.C. § 103, Obviousness

A. The Examiner rejected Claim 26 under 35 U.S.C. § 103 as being unpatentable over Shimano et al. in view of Farnsworth et al. (5,121,371). This rejection is respectfully traversed, as such claim is being cancelled herewith without prejudice or disclaimer.

B. The Examiner rejected Claim 4 under 35 U.S.C. § 103 as being unpatentable over Shimano et al. in view of Farnsworth et al. and Roth et al. (4,958,245). This rejection is respectfully traversed.

To establish prima facie obviousness of a claimed invention, all of the claim limitations

must be taught or suggested by the prior art. MPEP 2143.03. *See also, In re Royka*, 490 F.2d 580 (C.C.P.A. 1974) (emphasis added by Applicants). Applicants will now show that all of the claim limitations are not taught or suggested by the cited references, and thus a prima facie case of obviousness has not been established. In addition, as a prima facie case of obviousness has not been established, it is urged that Claim 4 is allowable¹.

A portion of Claim 4 is reproduced below, with highlighted sections being claimed features not taught or suggested by the cited references.

PORTION OF CLAIM 4:

an optical servo module structure for outputting a position signal to the positioning actuator, causing the positioning actuator to change a position of the magnetic head assembly, wherein the optical servo module structure comprises at least two optical servo modules, each comprising:
an optical beam source for emitting an optical beam;
at least a first and second detector for detecting an optical beam reflection,

As can be seen, Claim 4 is directed to at least two optical servo modules, and *each* of these at least two optical servo modules comprises at least a first and second (i.e. two) detector (in addition to an optical beam source for emitting an optical beam which is detected by such first and second detectors). Thus, there are at least four detectors (a first and second detector for one of the at least two optical servo modules, and a first and second detector for another of the at least two optical servo modules) for detecting an optical beam reflection. In rejecting Claim 4, the Examiner cites Shimano's two beam arrangement shown in Figure 20, apparently in an attempt to establish the claimed at least two optical servo modules. Applicants urge that while Shimano's Figure 20 shows two optical beams, these two beams *share a single optical detector* 2010 (page 11, paragraph [0114], last sentence of such paragraph). It is therefore urged that a prima facie case of obviousness has not been established with respect to Claim 4, as there are claimed elements not taught or suggested by the cited references.

¹ In the absence of a proper *prima facie* case of obviousness, an applicant who complies with the other statutory requirements is entitled to a patent. *See In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

The optical tracking system recited in Claim 4 can advantageously provide concurrent multi-track tracking as there are multiple optical servo modules, and thus the tracking system is tolerant to servo track imperfections (Specification page 9, lines 26-30; page 11, line 16 – page 12, line 13). Claim 4 thus provides a significant advancement to the state of the art, and is non-obvious in view of the cited references.

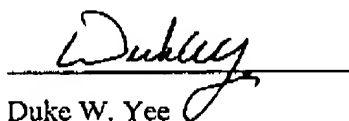
Therefore, the rejection of Claim 4 under 35 U.S.C. § 103 has been overcome.

IV. Conclusion

It is respectfully urged that the subject application is patentable over the cited references and is now in condition for allowance. The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

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Respectfully submitted,



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